

REMARKS

Applicants acknowledge receipt of an Office Action dated September 8, 2005. In this response, Applicants have cancelled claims 1, 4 and 13 without prejudice or disclaimer and have amended claims 2, 3, and 4-12 to correct various informalities and present claims in a format more conventional for U.S. patent practice, *e.g.* by removing reference numerals, inserting conventional transitional terms, such as “comprising,” and replacing the phrase “characterized in that” with “wherein.” In addition, Applicants have rewritten claims 2, 6, 8 and 9 in independent form and added claims 14-24. Support for the newly added claims may be found in the specification, *inter alia*, in the first two full paragraphs on page 5.

Following entry of these amendments, claims 2, 3, 5-12 and 14-24 are pending in the application.

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

Acceptance of Formal Drawings

During a review of their file, Applicants have noted that the PTO has not yet acknowledged acceptance of the formal drawings submitted on July 21, 2004. Applicants respectfully request that the PTO acknowledge acceptance of the drawings in its next communication.

Rejections Under 35 U.S.C. § 103 – Klipfel in view of Damsohn

On page 1 of the Office Action, the PTO has rejected claims 1-5, 12, and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 6,718,956 to Klipfel et al. (hereinafter “Kipfel”) in view of DE 199 62 863 to Damsohn et al. (hereinafter “Damsohn”). In this response, Applicants have amended claim 2, and Applicants submit that the rejection based upon the combination of Kipfel and Damsohn does not apply to amended claim 2 for the reasons set forth below.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143.03. Here, neither Klipfel nor Damsohn,

taken either individually or in combination, teaches or suggests an exhaust gas heat exchanger “wherein the closure member is designed as a pivotable half-flap, one longitudinal side of which is secured to a drive shaft arranged transversely with respect to the exhaust gas flow (A), and wherein the half-flap is arranged in a valve housing with an approximately rectangular cross section of flow and alternately closes off one half of the cross section or the other half of the cross section” as recited in amended claim 2. In particular, Applicants note that neither Klipfel nor Damsohn, teach or suggest a valve housing having “with an approximately rectangular cross section of flow.” This results in a considerably simplified valve mechanism compared to Klipfel’s valve with a circular cross section. For these reasons, Applicants submit that Klipfel and Damsohn cannot render claim 2, or any claim which ultimately depends from claim 2, obvious. Accordingly, Applicants submit that the outstanding rejection based upon Klipfel and Damsohn ought to be withdrawn.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §103 based upon Klipfel and Damsohn.

Rejection Under 35 U.S.C. §103 – Klipfel, Damsohn and DE ‘877

On page 2 of the Office Action, the PTO has rejected claims 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Klipfel in view of Damsohn as applied to claim 1, and further in view of DE 100 25 877 to Klipfel et al. (hereinafter “DE ‘877”). Applicants respectfully traverse this rejection for the reasons set forth below.

Here, Klipfel, Damsohn and DE ‘877, whether taken either individually or in combination, fail to teach or suggest “a pivot flap with an approximately centrally arranged pivot axle and two opposite sealing edges a partition with a concave sealing surface facing the pivot flap is arranged between the pivot axle and the inlet cross sections of the tube bundle and of the bypass passage, and wherein the downstream sealing edge slides along the sealing surface over the pivoting range” as recited in claim 6.

The arrangement disclosed in Fig. 7 of Klipfel does not correspond to the presently claimed pivot flap arrangement. Specifically, in contrast to the presently claimed arrangement, in Fig. 7 of Klipfel, the cylindrical valve element is rotatable. Damsohn and DE ‘877 add nothing to resolve this deficiency.

For this reason, Applicants submit that Klipfel, Damsohn and DE '877 cannot render claim 6, or any claim which ultimately depends from claim 6, obvious. Accordingly, Applicants submit that the outstanding rejection based upon Klipfel, Damsohn and DE '877 ought to be withdrawn. Applicants respectfully traverse this rejection for the reasons set forth below.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §103 based upon Klipfel, Damsohn and DE '877.

Rejection Under 35 U.S.C. §103 – Klipfel, Damsohn and Rinckel

On page 2 of the Office Action, the PTO has rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Klipfel in view of Damsohn as applied to claim 1, and further in view of U.S. 6,141,961 to Rinckel (hereafter “Rinckel”). Applicants respectfully traverse this rejection for the reasons set forth below.

Here, Klipfel, Damsohn and Rinckel, whether taken either individually or in combination, fail to teach or suggest an exhaust gas heat exchanger “wherein the closure member is designed as an angle flap with two limbs fixedly arranged approximately at right angles to one another and having a common apex, at which the closure member is mounted for rotation about a pivot axle, and wherein one limb selectively pivots about the pivot axle to respectively cover an inlet cross section of the tube bundle or the bypass passage while the other limb is oriented parallel to the exhaust gas flow (A).” as recited in claim 8.

In the Office Action, the PTO has focused on Figures 6 to 8 in Rinckel, particularly on valves 80 and 88, referring to these separate valves as, in the singular, “angle flap.” It can be seen even from the graphic representation of Figures 6 to 8 of Rinckel that it is not one angular valve as in the invention that is involved, but two non-angular valves, valve 80, on the one hand, and valve 88, on the other, that are linked to a spindle or shaft and move independently of one another. The different positions in Figures 6, 7 and 8 show that valves 88 and 80 assume different angles to one another, *i.e.*, they can turn toward one another. Valve 80 has a projection 94 which forms an abutment for valve 88, while valve 88 has a right-angle projection 96 which comes into contact with valve 80. With the valve 80, a shut-off valve, the main tube 16 is closed, and with valve 88 the flow cross section to the heat

transfer means 20 can be controlled: valve 88 is therefore a control valve which can turn when main tube 16 is shut off and valve 80 is closed. Thus, the Rinckel fails to disclose the presently claimed “angle flap.”

For these reasons, Applicants submit that Klipfel, Damsohn and Rinckel cannot render claim 8, or any claim which ultimately depends from claim 8, obvious. Accordingly, Applicants submit that the outstanding rejection based upon Klipfel, Damsohn and Rinckel ought to be withdrawn.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §103 based upon Klipfel, Damsohn and Rinckel.

Allowable Subject Matter

Applicants acknowledge, with appreciation, the PTO’s indication, on page 3 of the Office Action, that claims 9-11 would be allowable if rewritten in independent form. In this response, Applicants have redrafted claim 9 in independent form with minor alterations to present claims in a format more conventional for U.S. patent practice, *e.g.* by removing reference numerals, inserting conventional transitional terms, such as “comprising,” and replacing the phrase “characterized in that” with “wherein.” In view of this amendment, Applicants submit that claims 9-11 are in *prima facie* allowable form.

Newly Added Claims


In this response, Applicants have added claims 14-24. Applicants submit that each of these new dependent claims is allowable for the same reason as the independent claim from which each ultimately depends.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.